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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,385	12/08/2003	Stanley Merjan		2600

7590 01/25/2005

STANLEY MERJAN
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EXAMINER

LEE, JONG SUK

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,385

Applicant(s)

MERJAN ET AL.

Examiner

Jong-Suk (James) Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 6-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed November 8, 2004 has been entered.

Terminal Disclaimer

2. The terminal disclaimer filed November 8, 2004 does not comply with 37 CFR 1.321(b) and/or (c) because:

The person who has signed the disclaimer has not stated the extent of his/her interest, or the business entity's interest, in the application/patent. See 37 CFR 1.321(b)(3).

It fails to disclaim the terminal portion of the subject patent.

It should be noted that patent owner is required to pay disclaimer fee as set forth in 37 CFR 1.20(d).

Therefore, It is advised that Applicant may use USPTO Form, PTO/SB/25 which can be downloaded from USPTO official website and file with the proper fees.

Specification

3. The disclosure is objected to because of the following informalities:

Page 1, 1st paragraph: -- now, abandoned, -- should be inserted after "10/241,962 filed September 12, 2002" in order to clarify the status the parent application.

Appropriate correction is required.

Obviousness-Type Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[®] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5 and 10-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20, 25 and 26 of U.S. Patent No. 6,468,003 and claims 19 and 20 of U.S. Patent No. 6,309,143.

Although the conflicting claims are not identical, they are not patentably distinct from each other, for example, in claim 1 of present claimed invention and claim 1, 20 and 25 of '003 Patent, the Applicants claim:

"A pile comprising a hollow uniformly tapered steel body....a convex polygon having 8 to 24 sides,...the body being about 3 to 13 meters long, having a lower diameter which is about 200 mm to 400 mm and a larger upper diameter which about 300 mm to 600 mm and being of steel about 5 to 13 mm thick formed from a unitary sheet folded into said tapered polygon shape.....a

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circular cross-section such that said top can engage with, match and be butt-welded to the end of a straight pipe of corresponding circular cross-section....the construction and arrangement of said hollow body being such that said hollow body can be driven into the ground by hammer blows transmitted to the hollow unfilled top of said body and be filled with concrete thereafter."

Whereas in '003 Patent, the Applicants claim "In a pile having a hollow uniformly tapered steel body....a convex polygon having at least four sides," (see col.5, lines 30-40); "said convex polygon having 8 to 24 sides.." (see col.5, lines 47-48); "said tapered portion is of steel and is about 3 to 13 meters long and has a lower diameter which is about 200 mm to 400 mm and a larger upper diameter which about 300 mm to 600 mm and being of steel about 5 to 13 mm..." as recited in claim 1 (see col.5, lines 52-61); and

"In a pile as in claim 1, aid ring having a intergal inwardly extending shoulder on thiwh said pipe rests" as recited in claim 20 (see col. 6, lines 40-41); and

"In the process of driving a pile into granular soil, the improvement which comprises driing a pile having a structure of claim 20 by hammer blows transmitted to the top of said pipe and then filling said hollow portions with concrete" as recited in claim 25 (see col.6, lines 63-67).

And whereas in '143 Patent, the Applicants claim "A process which comprises the steps of driving a pile having a hollow uniformly tapered bottom load-bearing portion for extended engagement with the soil into which the pile is to be driven and to be filled with concrete after driving and a hollow straight upper load-bearing portion....." as recited in claim 19 (see col.6, lines 41-65).

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Therefore, in respect to above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claims 20, 25 and 26 of '003 and claims 19-20 of '143 Patent as a general teachings for a composite piling as claimed by the present application. The instant claims obviously encompass the claimed invention of '003 and '143 Patent and differ only in terminology. To the extent that the instant claims are broaden and therefore generic to the claimed invention of '003 and '143 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

Allowable Subject Matter

6. Claims 1-5 and 10-12 would be allowable **upon timely filing Supplemental Terminal Disclaimer in a proper format and fee.**

7. Claims 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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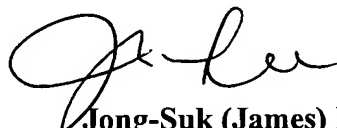
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl
January 21, 2005


Jong-Suk (James) Lee
Primary Examiner
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